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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 721,047	11 22 2000	Nilgun E. Tumer	OCIRS 3.3-060 CONT	2314

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600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

HELMER, GEORGIA L.

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07 15 2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/721,047

Applicant(s)

TUMER ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, 18-24 and 32, drawn to recombinant plant cells, classified in class 435, subclass 419, and to DNA, classified in class 536, subclass 23.1.
  - II. Claims 13-17, drawn to plants cells containing expressed proteins, classified in class 800, subclass 301.
  - III. Claims 25-31, drawn to proteins, classified in class 530, subclass 350.
  - IV. Claims 33-35, drawn to method of making disease resistant plants, classified in class 800, subclass 279.
  - V. Claims 36-37, drawn to methods of identifying Pap II proteins, classified in 435, subclass 70.1.

For each of the inventions of Groups I-III, restriction to one of the following is also required under 35 USC 121. Therefore, Applicant is required to elect one of inventions I-III, and one of inventions (a) – (dd).

- (a) SEQ ID NO: 3.
- (b) PAP II (1-285).
- (c) PAP II (1-285, G72D).
- (d) PAP II (1-285, L254R).
- (e) PAP II (1-285, L254A).

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- (f) PAP II (1-237).
- (g) PAP II (1-259).
- (h) PAP II (1-237).
- (i) PAP II (1-238).
- (j) PAP II (1-239).
- (k) PAP II (1-240).
- (l) PAP II (1-241).
- (m) PAP II (1-242).
- (n) PAP II (1-243).
- (o) PAP II (1-244).
- (p) PAP II (1-245).
- (q) PAP II (1-246).
- (r) PAP II (1-247).
- (s) PAP II (1-248).
- (t) PAP II (1-249).
- (u) PAP II (1-250).
- (v) PAP II (1-251).
- (w) PAP II (1-252).
- (x) PAP II (1-253).
- (y) PAP II (1-254).
- (z) PAP II (1-255).
- (aa) PAP II (1-256).

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(bb) PAP II (1-257).

(cc) PAP II (1-258).

(dd) PAP II (1-259).

Claim 32 appears to inadvertently depend on the wrong claim. The Office interprets Claim 32 to be dependent on Claim 18.

The inventions are distinct, each from the other, because of the following reasons:

2. Inventions (a)-(dd) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

3. Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The function of group I inventions is being a repository for DNA. The groups II inventions function to express proteins of interest. Group III inventions function as diagnostics in antigen-antibody reactions.

4. Inventions I and IV-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. This product can be used to generate disease resistant plants of Group IV, as a repository for maintaining DNA sequences of interest, or to identify Pap II proteins as set for in Group V.

5. Inventions II-III are unrelated to IV-V. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.

The products of Groups II and III are not required in the methods of IV and V.

6. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The method of making disease resistant plants is functionally distinct from the method of identifying Pap II proteins, as they utilize different reagents, have different steps, and different outcomes.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and their requiring different searches, restriction for examination purposes as indicated is proper.

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8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

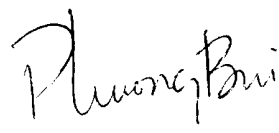
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer, PhD  
Patent Examiner  
AU 1638  
July 9, 2002



  
PHUONG T. BUI  
PRIMARY EXAMINER

7/10/02